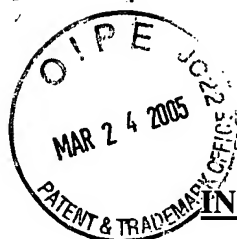


IFW



Docket No.: 051319-0060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Rikuro Obara
Serial No.: 10/669,517
Filed: September 24, 2003

Date of Deposit: March 22, 2005
I hereby certify that this paper or fee and enumerated documents is being deposited with the United States Postal Service "First Class Mail service under 37 CFR 1.8 on the date indicated above and is addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
Sarah Schlie
Sarah Schlie

For: **DOUBLE-ROW BALL BEARINGS AND DOUBLE-ROW BALL BEARING PRELOAD APPLICATION METHOD**

Examiner: Thomas R. Hannon Group Art Unit: 3682

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT OF FEBRUARY 22, 2005

Sir:

This is in response to the Restriction Requirement of February 22, 2005, on which the shortened statutory period for response expires on March 22, 2005. Accordingly, this Response is timely filed.

In response to the Restriction Requirement, Applicant elects Group I (Claims 1-32), with traverse.

The MPEP clarifies that the requirements that must be shown for a Requirement for Election of Species are the same as the requirements for a valid Restriction Requirement. MPEP § 809.02(a).

Applicant traverses the Requirement for Restriction between Groups I and II because the facts, as stated by the Examiner, do not meet the legal requirements for a proper Restriction.

MPEP §803 states the requirements for a restriction requirement (emphasis added):

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)); and

(2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP § 803 clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Applicant concedes that Groups I and II are distinct (criterion (1) of MPEP § 803), but traverses under criterion (2). The Examiner's paper omits any mention of criterion (2) — the Restriction raises no showing of a serious search burden. At a minimum, a Restriction Requirement without such a showing is incomplete.

Applicant submits that a search of Group II will necessarily result in a search of the independent claim of Group I as well.

In view of the lack of “serious burden,” Applicant requests that the Restriction between Groups I and II be withdrawn.

Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

Amendments to the Claims are reflected in the listing of the claims, which begin on page 4 of this paper.

Remarks begin on page 13 of this paper.